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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,540	09/28/2004	Albert Van Selst	SME-003	7794
36822	7590	11/17/2006	EXAMINER	
GORDON & JACOBSON, P.C. 60 LONG RIDGE ROAD SUITE 407 STAMFORD, CT 06902			HINZE, LEO T	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,540

Applicant(s)

VAN SELST, ALBERT

Examiner

Leo T. Hinze

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim, US 6,579,004 B1 (hereafter Kim) in view of Speciale, US 1,807,497 (hereafter Speciale).

a. Regarding claim 1:

Kim teaches an apparatus for indicating time comprising: a pointer arrangement including at least one first pointer (1, Fig. 1) and a second pointer (4, Fig. 1), the at least one first pointer providing an indication of local time by means of revolving movement over a dial with a pointer period of revolution of twelve hours (1 is a traditional hour hand, col. 2, l. 47), the second pointer providing an indication of a world time by means of revolving movement over the dial with a period of revolution of twenty-four hours ("hand 4 rotates once a day," col. 2, l. 37) in cooperation with a first scale (5, Fig. 1) present on the dial having a number of graduations that is a multiple of 25 (dial 5 marked to display 1000 beats," col. 1, l. 33); and a drive mechanism (inherently present, as both hands 1 and 4 rotate around the dial), coupled to said at least one first pointer and said second pointer, which is adapted to cause the revolving movement of said at least one first pointer and said second pointer.

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Kim does not teach the first scale having a number of graduations that is a multiple of 24.

Speciale teaches a clock with a scale having 288 graduations (11, Fig. 1), and that one having ordinary skill in the art would understand that “any desired arrangement and the markings therefor may be provided (p. 1, ll. 45-47).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Kim to include a number of graduations being a multiple of 24, because Speciale teaches that it is understood that one can use any markings desired, and a person having ordinary skill in the art would know that because a day has 24 hours, markings in a multiple of 24 may be desirable.

b. Regarding claim 2, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 1 above. Kim also teaches wherein the first scale has 360 degrees (the first scale 5 is a complete circle of 360 degrees, Fig. 1), each degree corresponding to a time interval of four minutes (360 divided by 24 hours equals 4 minutes per degree).

c. Regarding claim 3, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 1 above. Kim also teaches wherein said at least one first pointer is independently adjustable with respect to said second pointer so as to set a time that differs in dependence on location, while said second pointer continues to indicate world time (col. 3, ll. 10-15, user adjusts hands 1 and 2 separately).

d. Regarding claim 4, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 2 above. Kim also teaches wherein said at least one first pointer comprises three pointers (1, 2, 3, Fig. 1).

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e. Regarding claim 5:

The combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 1 above. Kim also teaches a second scale corresponding to an interval of twelve hours (tic marks at hour locations on dial, Fig. 1).

The combination of Kim and Speciale as applied to claim 1 above does not teach a third scale corresponding to an interval of twenty-four hours, and wherein said first scale is divided into 360 units.

Speciale teaches a scale corresponding to an interval of twenty-four hours (number 10, Fig. 1), and that one having ordinary skill in the art would understand that “any desired arrangement and the markings therefor may be provided (p. 1, ll. 45-47).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Kim to include a third scale corresponding to an interval of twenty-four hours as taught by Speciale, as well as dividing the first scale into 360 units, because Speciale teaches that it is understood that one can use any markings desired, and a person having ordinary skill in the art would know that because a circle has 360 degrees, 360 markings around the dial may be desirable.

f. Regarding claim 6:

The combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 5 above, including wherein said first and second scales are arranged in a fixed position. Kim teaches that the third scale is an adjustable rotary ring (5, Fig. 1).

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The combination of Kim and Speciale as applied to claim 5 above does not teach wherein the third scale is arranged in a fixed position.

It has been held that mere omission of an element if the element is not desired is not sufficient to patentably distinguish an invention over the prior art. See MPEP §2144.04(II)(A).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Kim wherein the rotatable ring was no longer rotatable, because a person having ordinary skill in the art would recognize that this feature could be removed or disabled if it was not desired.

g. Regarding claim 7, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 5 above, including wherein said first and second scales are arranged in a fixed position. Kim teaches that the third scale is an adjustable rotary ring (5, Fig. 1).

h. Regarding claim 9, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 1 above. Kim also teaches a clock face having a visible portion with a legend (see writing and logo on watch, Fig. 1).

i. Regarding claim 10, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 1 above. Kim also teaches a watch (Fig. 1).

j. Regarding claim 11, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 1 above. Kim also teaches wherein said at least one first pointer includes a slowest pointer with a period of revolution of twelve hours (hour hand 1, Fig.

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1))and at least one faster pointer with a period of revolution less than twelve hours (minute hand 2, second hand 3, Fig. 1).

k. Regarding claim 12, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 11 above. Kim also teaches wherein said at least one faster pointer includes a pointer with a period of revolution of one hour and another pointer with a period of revolution of one minute (minute hand 2, second hand 3, Fig. 1).

l. Regarding claim 13, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 1 above. Kim also teaches an electronic appliance (electronic watch, Fig. 1).

m. Regarding claim 14, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 13 above. Kim also teaches wherein the watch is capable of operation as part of a personal computer system.

It appears that applicant is not positively claiming a personal computer system, but simply the capability of operating in combination with a personal computer system.

n. Regarding claim 15, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 13 above. Kim also teaches wherein the watch is capable of operation as part of a mobile telephone.

It appears that applicant is not positively claiming a mobile telephone, but simply the capability of operating in combination with a mobile telephone.

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o. Regarding claim 16, the combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 13 above. Kim also teaches wherein the watch is capable of operation as part of an instrument panel in a car, train or airplane.

It appears that applicant is not positively claiming an instrument panel in a car, train or airplane, but simply the capability of operating in combination with an instrument panel in a car, train or airplane.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Speciale as applied to claim 1 above, and further in view of Ushikoshi, US 4,436,435 (hereafter Ushikoshi).

The combination of Kim and Speciale teaches all that is claimed as discussed in the rejection of claim 1 above.

The combination of Kim and Speciale does not teach time indication in the form of a block with changing numerals associated with said second pointer.

Ushikoshi teaches a watch with both an analog (33, Fig. 6) and digital (45, Fig. 6) display.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to further modify Kim to include an additional digital display as taught by Ushikoshi, because a person having ordinary skill in the art would recognize that this additional display could provide additional, important time information to a user in a digital format, thereby making it easier for someone who is confused by traditional analog hand to correctly determine the time.

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Response to Arguments

4. Applicant's arguments filed 31 August 2006 have been fully considered but they are not persuasive.

5. In response to applicant's arguments on pp. 6 and 7 against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rejections above show that Kim teaches all of the features of claim 1 except for a first scale having a number of graduations that is a multiple of 24. The examiner has modified Kim using the teaching in Speciale that any desired arrangement and markings therefor may be provided on a watch face.

6. In response to applicant's argument on p. 7 that incorporation of the features of Speciale would result in a watch with two 24 hour hands, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the combined teachings of Kim and Speciale would teach one of ordinary skill in the art to modify Kim to change the markings so that they are a multiple of 24.

7. In response to applicant's argument on pp. 7-8 based upon the age of Speciale, contentions that the reference patents are old are not impressive absent a showing that the art

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tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is (571) 272-2167. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leo T. Hinze
Patent Examiner
AU 2854
07 November 2006

A handwritten signature in black ink, appearing to read "Judy Nguyen", is positioned above the printed name.

JUDY NGUYEN
SUPERVISORY PATENT EXAMINER